



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Abe Nishiki

Appeal No. _____

Serial No.: 10/687,748

Group Art Unit: 3734

Filed: 10/20/2003

Examiner: Blatt, Eric D.

For: **A PLIERS-LIKE TOOL AND PROCESS FOR CURING PHIMOSIS**

* * * * *

SECOND REPLY BRIEF

* * * * *

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Members of the Board of Patent Appeals and Interferences:

The jurisdiction of the Board is invoked under 35 USC 134 and 37 CFR 1.191. A Notice of Appeal and payment therefor and payment for filing a Brief were filed March 20, 2008.

It is requested that the Appeal previously paid for be maintained. That brief was filed in response to the Examiner's Third New Grounds of Rejection in this application mailed 12/28/2007. That Notice of Appeal and Appeal Brief were timely filed.

A Reply Brief was timely filed in response to the Examiner's Fourth New Grounds of Rejection and first new grounds of rejection mailed on 10/02/2008 in response to the Appeal Brief mailed March 20, 2008.

This Second Reply Brief (third brief) is timely filed in response to the Examiner's Fifth New Grounds of Rejection and second new grounds of rejection mailed 06/08/2010 after the filing of the Second Brief.

The most pertinent portions of the Appeal Briefs are reproduced herewith for convenience.

Table of Contents

<u>Item</u>	<u>Page</u>
Identification	1
Table of Contents	3
i. Real party in interest	5
ii. Related appeals and interferences	6
iii. Status of claims	7
iv. Status of amendments	8
v. Summary of claimed subject matter	9
vi. Grounds of rejection to be reviewed on appeal	11
vii. Arguments	12
References	
Chang	12
Ramamurti et al	12
Brennan et al	13
Seber et al	13
35 USC 112 Rejections	13
35 USC 102 Rejections (Chang)	17

Table of Contents (Cont.)

<u>Item</u>	<u>Page</u>
35 USC 103 Rejections	18
Claims 3, 5 and 12–16 (Chang and Ramamurti et al)	18
Claims 4 and 6–8 (Chang and Ramamurti et al and Seber et al)	19
Claims 9 and 10 (Chang and Brennan et al)	20
Applicable Law	21
35 USC 112	21
35 USC 102	22
35 USC 103	23
1. Claim Preamble	23
2. Non-analogous Art	24
3. Function Ignored	24
4. Problem Addressed	25
5. Combining Prior Art References	26
6. References Require Modification	27
7. Hindsight	27
Art Rejections Summary	28
Conclusion	29
viii. Claims Appendix	30
ix. Evidence Appendix	36
x. Related Proceedings Appendix	37

i. Real Party of Interest

The real party of interest is Abe Nishiki whose mailing address is: 121-9, Aza Maehata, Oh-Aza Myogazawa, Matsuyama-machi, Atsumi-gun, Yamagata Pref. Japan

ii. Related Appeals and Interferences

There are no known related appeals or interferences.

iii. Status of Claims

Claims 1-16 are present in this application.

Claims 3–8 and 12 are rejected under 35 USC 112, 1st paragraph, as failing to comply with the enabling requirement.

Claims 1, 2 and 11 are rejected under 35 USC 102(e) as being anticipated by Chang.

Claims 3, 5 and 12–16 are rejected under 35 USC 103(a) as being unpatentable over Chang in view of Ramamurti.

Claims 4, and 6–8 are rejected under 35 USC 103(a) as being unpatentable over Chang in view of Ramamurti and Seber et al.

Claims 9 and 10 are rejected under 35 USC 103(a) as being unpatentable over Chang in view of Brennan et al.

iv. Status of Amendments

There are no pending amendments.

v. Summary of Claimed Subject Matter

As set forth in the only independent claim 1, and dependent claims 2 - 16, the basic invention is disclosed in the Abstract (page 22 of the Specification). A plier-like device has handles 2L, 2R, that fulcrum on pivot pin 5 such that jaws 4R, 4L have upturned blades 3R, 3L with end ball hooks 3a that separate as the handles are brought together. A rack 8 pivots on a pin 9 to position the blades by use of pawl 7 (Figs 1 and 2; page 5, lines 5 through 20). These are set forth in claims 1 - 3, 5, and 9 - 12. The rack can have a guide groove 14, accommodating a spring-loaded projection 12, with a stop 16 to limit pivotal movement. The guide groove has a tapered surface at one end 14a to disengage the rack from the projection (page 9, lines 5 - 21) claims 6 - 8. As shown in Fig. 5, (page 11, lines 1 - 12) the rack can have an internal slit or slot 23, that accommodates a pawl 7, as set forth in claim 4. As shown in Fig. 6, the handles 32L, 32R, jaws and blades 34L, 34R can all be one integral shaped spring element (page 12, line 19 - page 13, line 16) with a flat rack 37 having cogs 38 that engage with the handle 32L of the spring element 31, claims 13 - 15. The fulcrum 5 includes a spring to open the grips 2R and 2L while closing the blades 3R and 3L (page 5, lines 8 and 9), claim 16.

Claims 1 - 3, 5 and 9 - 12 address the handle, jaw, blade, ratchet, and details of the enlarged hook means shown in Figs. 1 and 2.

Claim 4 adds to claim 3 the rack having a slot 23 that accommodates the pawl shown in Fig. 5.

Claims 6 - 8 add to claim 3 the rack having a guide groove 14 for accommodating a spring projection controlling rack movement of Fig. 1.

Claims 13 and 14 add to claim 1 that the handle, jaw and blade are all one integral shaped spring element as shown in Fig. 6.

Claim 15 adds to claim 14 the flat rack 37 having cogs on one side that engage one handle of the integral spring element.

Claim 16 adds to claim 2 a spring 10 with the fulcrum pin 9 for biasing the cogs on the rack 8 toward the pawl 7.

vi. Grounds of Rejection to be Reviewed on Appeal:

If claims 3–8 and 12 are enabling under 35 USC 112, first paragraph.

If claims 1, 2 and 11 are anticipated by Chang under 35 USC 102(e).

If claims 3, 5 and 12–16 are obvious over Chang in view of Ramamurti under 35 USC 103(a).

If claims 4 and 6–8 are obvious over Chang in view of Ramamurti and Seber et al under 35 USC 103(a).

If claims 9 and 10 are obvious over Chang in view of Brennan et al under 35 USC 103(a).

Claim Grouping

Of the claims, claim 1 and claim 3 and claim 4 and claim 6 and claim 8 and claim 9 and claim 15 are considered to be independently patentable.

Claims 2, 11, 13, 14 and 16 are considered to be grouped with and patentable with claim 1.

Claims 5 and 12 are considered to be grouped with and patentable with claim 3.

Claim 7 is considered to be grouped with and patentable with claim 6.

Claim 10 is considered to be grouped with and patentable with claim 9.

vii. Arguments

The Examiner's References

Chang

The patent to Chang (U.S. 6,663,562) is to a “SURGICAL RETRCTOR” for bone retracting access to underlying long bones through incisions (column 1, lines 9–15). As seen in Fig. 1, the device resembles a pair of pliers with loops 20 on handles 16 for gripping and moving arms 18 about a pivot 14 such that moving the loops together spreads the arms apart. A ratchet 30 on the handles enables the arms to be locked in the open position. Blades 78 are attached on the arm ends (Abstract). The blades 78 on the arm ends are attached by a knee joint (Figs. 2, 5 and 6; col. 5, lines 54–65) allowing the blades to pivot parallel and perpendicular to the arms. The blade distal ends are sharp and curved (Figs. 7 and 8; col. 6, lines 9–15).

Ramamurti et al

Ramammurti et al (U.S. 6,635,072) is to a pliers-shape tool having a “SAFETY RATCHET MECHANISM.” As shown in Fig. 1, when the handles grips 21 are moved together the jaws of the pliers 24, 26 move together to close on an object. The ratchet (bar 30) is pivoted about pin 34. The pawl (tooth bar 30) has the teeth 42 positioned so that the bar teeth slip over each when closing and engage to prevent opening unless the teeth are removed from contact with the pawl 58 (Fig. 6).

Brennen et al

The patent to Brennan et al (U.S. 6,450,975) is to an “Ultrasonic Transmission Guide Wire.” The wire has a core of ultrasonic transmission material with a distal end comprising a smooth ball tip for a traumatic application of ultrasonic energy to biological tissue” (Abstract). The end is referred to as a “distal ball 16” or “a distal head 16” (column 6, lines 3 and 23).

Seber et al

Seber et al (U.S. 6,748,829) discloses five separate embodiments of “Self-Adjusting Pliers” (Title, Brief description of the Drawings; Fig. 17; column 4, lines 30 and 31). In each of the embodiments one handle 22 has a blade 24 integral while a second handle 56 is separate from the second blade 76 and pivots 98 therewith. Two slots 40, 42 provide for a slider 84, to keep the lower jaw 78 perpendicular to the upper jaw 24, and a pawl 86 (column 5, line 58 - column 6, line 23). The pawl provides for adjusting the distances between the blades 24,76 (column 6, lines 46+).

35 USC 112 Rejection

Claims 3–8 and 12

Claims 3–8 and 12 are rejected under 35 USC 112, 1st paragraph, as failing to comply with the enabling requirement. Claims 4–8 and 12 all depend from claim 3.

Claim 3, line 2, includes a pawl and line 5 includes “said pawl is attached to said second handle grip second end by a second pivot pin.”

Attention is directed to the Specification (page 6, lines 8 and 19) wherein it includes "a pawl 7 pivotably held by a second pivot pin on one handle grip 2R." There are numerous references to pawl 7 shown in Figs. 1, 3a, b and 5.

After over 6 years and four new grounds of rejection, the examiner has concocted or envisioned a situation whereby the recited structure may not function. There is nothing inappropriate or insufficient with the disclosure or claims.

After three Office Actions affirming that the drawings were acceptable (page 1, Office Action of 01/04/2007, and again on page 1 of the Office Action mailed 07/06/2007, and again on page 1 of the Office Action mailed 12/28/2007) and almost seven years and an Appeal Brief to scrutinize the drawings, the examiner has determined that no mechanic in the art, skilled or not, would be able to understand the pawl and ratchet pin.

This prosecution history alone negates the examiner's newly perceived problems dealing with 35 USC 112. Texas Instruments v. United States ITC, 10 USPQ 2d 1257 (Fed Cir 1989)

As well established, the specification is addressed to the mechanic in the art, not an incompetent idiot, and the inventor is free to describe components of his invention. The operation is perfectly obvious as explained and the examiner has speculated as to a confusion that is irrelevant and immaterial to the invention as disclosed and claimed. The examiner then proceeds to create a structure with a function that is not present and that is envisioned to create

inoperability. The overactive imagination when interpreting the prior art structure is bad enough but creating an inoperative, non-existent structural limitations in the invention combination goes beyond anything acceptable in the patent statutes. To even imply that the mechanic could be incapable of understanding the simple pawl and ratchet, in view of the hundreds in use for centuries, is an insult.

Note that if a pivotal motion is optional no specific amount of pivot is set forth. A small pivot, if present, will facilitate removal of the pawl from the cog. This could be seen by looking at the cog shape and depression as seen in Fig. 5, for example. The need would depend on the pawl and cog shape selected. In any event, such is not properly in issue and is irrelevant.

The pertinent laws, all of which have been ignored and violated, include:

1. Rather than addressing the facts and specific claim wording subjective opinions have been made. Subjective opinions are of little weight against contrary evidence. In re Wagner et al, 152 USPQ 552 (CCPA 1967).
2. Even if some minimum experimentation on pivotability were necessary, such would not preclude patentability. In re Borkowski, 164 USPQ 642 (CCPA 1970).
3. Inventors can and do omit factors presumed to be within the level of ordinary skill in the art and the mere possibility of the inclusion of inoperative subject matter does not prevent allowance of broad claims. In re Cook and Merigold, 169 USPQ 298 (CCPA 1971).
4. The examiner has suggested no plausible reason the term and use of “pitoval” is anything other than as stated in the specification and standard practice. Such a contrary reading

is not permissible. In re Salem, 193 USPQ 58 (CCPA 1980); In re Marosi, 218 USPQ 289 (FedCir 1983); In re Kohler et al., 204 USPQ 702 (CCPA 1980); In re Sneed, 218 USPQ 385 (FedCir 1983); In re Prater, 162 USPQ 541 (CCPA 1969).

5. Even if broad claims cover one or more inoperative species, the burden is on the examiner to show that the claims cover inoperative species and not on the applicant to show that it does not. In re Vickers and Herman, 61 USPQ 122 (CCPA 1944).

6. With respect to the specification and claims, they are addressed to the person of average skill in the particular art. Compliance with 112 must be adjudged from that perspective, not in a vacuum. It is always possible to theorize some combination of circumstance which would render a claim inoperative but those skilled in the art would assuredly not choose such a combination. It is not the function of claims or specifications to exclude all inoperative substances; it is not a valid basis for rejection that it is possible to argue that claims encompassed inoperative embodiments on the premise of unrealistic or vague assumptions Ex parte Cole, Howarth and Redding, 223 USPQ 95 (PO BdApp 1983); Ex parte Janin, 209 USPQ 761(PO BDApp 1979); In re Bode, Nolan, Baker, Mathias and Pfaender, 193 USPQ 12 (CCPA 1977).

7. The Board of Appeals has stated that they will not affirm the examiner on a rejection that is based on suspicion of inoperativeness. Ex parte Adams, 77 USPQ 482 (POBA 1947).

The examiner's imaginary problem and objections find no support in fact or law.

35 USC 102(e) Rejection

Claims 1, 2, and 11

Claims 1, 2 and 11 are rejected under 35 USC 102(e) as being anticipated by Chang.

The rejection fails to meet the 35 USC 102 criteria for anticipation. The rejection fails to even meet the claim preamble. Chang does not disclose a “phimosis curer.” The Chang device is to a “SURGICAL RETRACTOR” (Title). It includes retractor blades. The blades are designed to clamp onto a bone so as to hold flesh apart.

Claim 1 requires the blades to extend upward for insertion into a foreskin. The blades of Chang do not extend into any particular direction. The whole gist of the Chang blades is to avoid unidirectional extension. His invention has to have the blade rotate both in parallel and perpendicular directions.

Claim 1 requires the ratchet means to pivot “between first and second handle grips.” There is no pivotal movement of the ratchet means 30 of Chang between the first and second handle grips. The ratchet 32 of Chang is stationary on one of the grips 20 and merely slides under the other grip 20.

Claim 1 requires enlarged hook means on the blade second end with lines 21–29 reciting the details of the hook means that the examiner has totally ignored. Chang has no such hook means. The second ends of Chang’s blades have sharp tapered curved ends.

Claim 1 requires that the enlarged hook means have tip sides that protrude and rear sides that protrude. The sharp tapered curved ends of Chang do not meet either this structure or its slippage prevention or damage prevention.

Claim 2 includes the limitations of claim 1 and is patentable therewith.

Claim 11 requires the grips and jaws and blade and hooks to be integral. “The entirety of the device is one integral part since all of the elements work together to form an integrated device.” finds no support in the reference or in the disclosure of the present invention. The meaning of the claim terms is to be found in the Specification not in the examiner’s opinion.

Chang does not anticipate any one of claims 1, 2 and 11.

35 USC 103 Rejections

Claims 3, 5 and 12-16

Claims 3, 5 and 12–16 have been rejected under 35 USC 103(a) as being unpatentable over Chang in view of Ramamurti et al.

All of Claims 3, 5 and 12-16 are dependent from claim 1 and are allowable therewith.

Claim 3 requires a curved rack with its first end attached to the first handle grip second end by a first pivot pin with the pawl attached to the handle grip second end by a second pivot pin. Dependent claims 3, 5 and 12 depend from claim 3 and address the rack configuration and cog and pivot operation. The Ramamurti et al pliers jaws 24 come together when the handles 22 come together and they teach a linear rack bar. The pawl 58 is fixed and is in fact a stationary

integral part of the handle 58 and the “pin” 62 is in fact a stop that is also a permanent fixture in the same handle 22 and the two are spaced apart enough for the flat rack to slide between them far enough for the rack to pivot between them (paragraph sharing columns 5 and 6 and column 6 line 64—column 7, line 11).

As claim 11, claim 13 requires that the grip; jaws, blades and hooks be integral. Neither Chang nor Ramamurti et al teach or suggest such a structure and do not render the claims obvious.

Claims 14 and 15 depend from claim 13 and are allowable therewith. Claim 15 additionally requires the ratchet means set forth in claim 3 and is allowable therewith.

Claim 16 depends from claim 2 and is allowable therewith.

Chang and Ramamurti et al are drawn to nonanalogous art and the combination of the two does not render claims 3, 5 and 12–16 obvious.

Claims 4 and 6–8

Claims 4 and 6–8 are rejected under 35 USC 103(a) as being unpatentable over Chang in view of Ramamurti et al and Seber et al.

Claim 4 depends from claim 3 and is allowable therewith. Claim 4 in addition includes a slot in its inner length with a pawl therein and details thereof.

Claims 6–8 depend from claim 3 and are allowable therewith. Claims 6-8 additionally require the curved rack lower surface to have a groove with a spring loaded projection against the rack lower surface and a stop to limit pivotal movement of the rack.

Claim 7 additionally requires the guide groove to control pivotal movement of the rack and claim 8 has a decreasing depth groove. Neither Chang nor Ramamurti et al nor Seber et al teach the structural combination or its function.

Not one of claims 4 and 6–8 are made obvious by combining Chang with Ramamurti et al and Seber et al.

Claims 9 and 10

Claims 9 and 10 have been rejected under 35 USC 103 as being unpatentable over Chang in view of Brennan et al. The examiner declares that Chang discloses the claimed invention “except for the enlarged hook means being in the general shape of a ball” and being coated with an inert material.

Claims 9 and 10 depend from claim 1 and are allowable therewith.

Claim 1 requires two enlarged hook means on the blades having tip sides and front sides and rear sides with the tip sides protruding and the rear sides protruding to “prevent said first

blade and said second blade from slipping out of a foreskin opening" when within a foreskin opening so as not to damage the foreskin. Chang provides no such structuring and, as can be seen at 82 in Fig. 1 and Figs. 7A, 7B, 8A, and 8B, Chang teaches the exact opposite by providing sharp curved distal ends on the blades 78 that would damage any foreskin they were inserted into.

As to Brennan et al, the patent is drawn to a non-analogous art of applying ultrasonic energy to tissue. The distal end of Brennan et al is, in fact, a ball. This does not meet the structure claimed and certainly does not disclose or suggest a generally ball shape with spaces provided to preclude damage to the penis glands and from pinching the foreskin. Contrary to the examiner's allegation that the ball of Brennan et al minimizes trauma, it is specifically for creating trauma in that it applies ultrasonic energy to the biological tissue it contacts (Abstract).

The combining of Brennan et al with Chang is not a proper combination and relates non-analogous art and makes a combination that is expressly in opposition to the implied and actual teaching of the references. Claims 9 and 10 are not obvious over Chang in view of Brennan et al.

Applicable Law

The legal requirements for rejecting claims have not been met.

35 USC 112, 1st Paragraph, Rejection

Claims 3–8 and 12 are rejected under 35 USC 112, 1st paragraph.

The pertinent law relating to the first paragraph of 35 USC 112 is set forth above on pages 15 and 16.

35 USC 102(e) Rejection

Claims 1, 2 and 11 have been rejected under 35 USC 102(e) as being anticipated by Chang. As to anticipation, the basic requirements necessary for making a 35 USC 102(e) anticipation rejection have not been complied with.

The claimed structure is to a phimosis curer. The patent to Chang is to a surgical retractor. The ratchet segment 30 of Chang does not pivot as claimed. The blade structure of Chang is to bite onto bones while the enlarged hook structure claimed is to prevent damage to flesh with specific structure. To constitute an appropriate rejection under 35 USC 102 requires that the disclosure or prior patent be read unaided by teachings of the subject matter which they are alleged to anticipate. Technical Tape Corp. v. Minnesota Mining and Mfg. Co., 110 USPQ 160 (D.C.S.D. NY 1957). There can be no 35 USC 102 anticipation unless all of the same elements are found in exactly the same situation and united in the same way to perform identical functions as a single prior art reference. Corometrics Medical Systems v. Berkeley Bio-Engineering, 193 USPQ 467 (D.C.N.D. Calif. 1977); Johnson & Johnson v. Gore & W.L. Gore & Assoc., 195 USPQ 487 (D.C. Del. 1978); Scott v. Inflatable System, 222 USPQ 460 (9th Cir. 1983). The functional language recited in the claims precludes a 35 USC 102 rejection. Functional language in claims must be given full weight and may not be disregarded in evaluating patentability. Ex parte Bylund, 217 USPQ 492 (BdApp1981).

35 USC 103(a) Rejections

No legally acceptable obviousness rejection has been made. The references are all drawn to non-analogous art and fail to conform to requirements for combining references and taken together do not teach either the structure or function claimed.

1. Preamble

The references do not meet the Preamble. Claims 1–16 are allowable because a phimosis curer is being claimed and not one of the references teaches curing phimosis.

The preamble recites a phimosis curer and the claims clearly address the structure and function, i.e. “insertable into a foreskin opening.” “protrude to prevent . . . slipping out of a foreskin,” “so that said phimosis curer will not damage the foreskin when it is inserted into the foreskin.” As here, when a preamble is essential to understanding the claim itself, the relevant prior art is limited. Freund Industrial Co. V. Driam Mettall Product GmbH Co., 12 USPQ 2d 1641 (DCSNY 1989). While the preamble is not normally considered part of the claim, it is deemed part of the claims where necessary to breath “life and meaning” into the claims. Corning Glass Works v. Sumitomo Electric USA, 9 USPQ 2d 1962 (Fed Cir 1989). The purpose set forth in the preamble is more than a mere statement of purpose, it is essential to particularly point out the invention defined by the claims. The limitations appearing in the preamble are necessary to give meaning to the claims and properly define the invention. In re Bullock, 203 USPQ 17 (CCPA 1979); Computervision Corp., 221 USPQ 669 (Fed Cir) cert. Denied, 469 U.S. 857 (1984).

2. Non-analogous Art

The references are not analogous to the invention. Claims 1 - 16 are allowable because the references applied are all from non-analogous arts and are not properly combinable.

Determining non-analogous art is two-fold: first, court decides if reference is within field of inventor's endeavor; if it is not, court proceeds to determine whether reference is reasonably pertinent to particular problem with which inventor was involved. In re Wood and Eversole, 202 USPQ 171 (CCPA 1979). For the teachings of a reference to be prior art under 35 USC 103, there must be some basis for concluding the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention pertains. For no matter what a reference teaches, it could not have rendered obvious anything, "at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains, " unless said hypothetical person would have considered it. In re Horn, Horn, Horn, and Horn, 203 USPQ 969 (CCPA 1979).

In the instant case, none of the references are from the inventor's field of endeavor, and none of the references address the problem the inventor is solving.

3. Function Ignored

The references do not teach the function or claim wording. Claims 1 - 16 are allowable because not one of the references discloses the wording claimed or the function recited in relation to the claimed structure.

Combining separate teachings in the prior art references must be based on a suggestion or motivation therefor. All words of the claim must be considered in judging the patentability of a claim against the prior art. In re Miller, 169 USPQ 597 (CCPA 1971). A rejection cannot be sustained when the prior art is incapable of functioning as required by the claims and achieving what is achieved by the invention. When this situation exists, the Examiner has failed to make out a *prima facie* case. Ex parte Gould, 231 USPQ 943 (Bd App 1986). The requirements of a claim cannot simply be ignored. In re Ehrreich et al., 200 USPQ 504 (CCPA 1979). To show obviousness the structure of the references must perform the same function in substantially the same way to produce substantially the same result. Pennwalt Corp. v. Durance Wayland, Inc., 4 USPQ 2d 1737 (CAFC 1987).

4. Problem Addressed

Claims 1 - 16 are allowable because the claims are drawn to the problem of curing phimosis and not one of the references addresses the phimosis problem solution. The claims and references all address different problems.

The prior art must address and provide the inventor's answer to the particular problem confronting an inventor. In re Winslow, 151 USPQ 48 (CCPA 1966). The relationship between the problem the inventor was attempting to solve and the problem to which any prior art reference is directed is highly relevant. Stanley Works v. McKinney Mfg. Co, 216 USPQ 298 (Del DC 1981); In re Luvisi and Nohejl, 144 USPQ 646 (CCPA 1965).

5. Combining Prior Art References

Claims 1 - 16 are allowable because the references are not properly combinable. There must be a motivation to combine different aspects of an invention. No mechanic in an art would combine one reference with another that would render the first inoperative in whole or in part.

An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. Ex parte Levengood, 28 USPQ 2d 1300 (BdApp 1993). The references must show at least part of the claimed invention. It is fundamental that a valid reference is good for what it discloses and must show all or part of the invention for which a patent is sought. In re Stemple, Jr., 113 USPQ 77 (CCPA 1977). The references combined must have a reasonable chance of success. Criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the combination of references should be carried out and would have a reasonable likelihood of success viewed in the light of prior art. In re Dow Chemical Co., 5 USPQ 2d 1531 (Fed.Cir. 1988). Claims are allowable when nothing in the prior art supports the rejection. Where nothing in the prior art suggests to one of ordinary skill in the art the desirability of combining the features shown in the different references, the claims should be held to be allowable. In re Osweiler, 145 USPQ 691 (CCPA 1965). The claim is allowable when any one element of a combination is not obvious. Where a claim to a combination includes one or more elements that is by itself nonobvious, then the entire claim meets the nonobvious test of 35 USC 103. In re Hirao, 190 USPQ 15 (CCPA 1976).

6. References Require Modification

Claims 1 - 16 are allowable because the references are not properly combinable and the references when combined do not teach the claimed structure.

Patents are references only for what they clearly disclose or suggest. It is not proper use of a reference to modify its structure to one which prior art references do not teach. In re Randal et al, 165 USPQ 586 (CCPA 1979). The totality of the prior art leads away from the claimed invention. In re Hedges, 228 USPQ 685 (CAFC 1986). The claimed device need not necessarily be better than the prior art. A combination of references which requires a change in the basic principle, under which the basic reference was designed to operate, is improper. In re Ratti, 123 USPQ 349 (CCPA 1959).

7. Hindsight rejections.

The rejections are based on hindsight. Claims 1 - 16 are allowable because the random collection of prior art and the interpretation of the prior art clearly indicates an attempt to splice elements from the references into the claimed subject matter based solely on applicant's disclosure. The fact that the prior art elements are being misrepresented and combined in a manner that is inconsistent with their use and that they render the prior art devices inoperative for their intended purposes clearly shows a hindsight reconstruction. More than an opinion or speculation and hindsight are required to reach a legal conclusion of obviousness. In re Sporck, 133 USPQ 360 (CCPA 1962). A combination rejection must be supported by something other than applicant's own disclosure. In re Shaffer, 108 USPQ 326 (CCPA 1956). To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or

references of record suggest that knowledge is hindsight where that which only the inventor taught is used against its teacher. W.L. Gore & Associates v. Gorlock Inc., 220 USPQ 303 (CAFC 1983); In re Harry Sponnoble, 160 USPQ 237 (CCPA 1969). The use of appellant's disclosure in reconstruction of references to meet claims is barred since, under 35 USC 103, obviousness must be tested at the time the invention was made; and, claims are allowable when the only source which would leave a person of ordinary skill to make the last step in reconstruction is appellant's disclosure. In re Pavlecka, 138 USPQ 152 (CCPA 1963).

ART REJECTIONS SUMMARY

The claims are not obvious:

- (a) None of the references are from the inventor's field of endeavor.
- (b) None of the references are from the same art.
- (c) None of the references address the inventor's problem.
- (d) None of the references are properly combined.
- (e) None of the references individually or collectively teach the claim structure.
- (f) None of the references individually or collectively can perform the claim function.
- (g) The rejections are no more than an attempt to collect individual components from extraneous patents and splice them together to reject the claims based only on the claim structure and the examiner's imagination.

The claims define a patentable invention that is enabling, definite and not obvious in view of the references of record.

CONCLUSION

Claims 1–16 define patentable subject matter and are in condition for allowance. The examiner's rejection of claims 3–8 and 12 under 35 USC 112, 1st paragraph; and claims 1, 2 and 11 under 35 USC 102(e); and claims 3–10 and 12–16 under 35 USC 103(a) should be reversed, and such action is respectfully requested.

Respectfully submitted,



Clyde I. Coughenour
Reg. No. 33,083

Clyde I. Coughenour
16607 Sutton Place
Woodbridge, VA 22191-4627
(703) 221-8677

viii CLAIMS APPENDIX

Claims on Appeal

Claim 1. A phimosis curer comprising;

a first handle grip having a first end and a second end and a second handle grip having a first end and a second end;

a first jaw having a first end and a second end and a second jaw having a first end and a second end;

a first blade having a first end and a second end and a second blade having a first end and a second end;

said first handle grip second end and said first jaw first end are joined together;

said second handle grip second end and said second jaw first end are joined together;

said first blade first end and said first jaw second end are joined together;

said second blade first end and said second jaw second end are joined together;

said first blade and said second blade extend upwardly from said first jaw and said second jaw respectively so as to be insertable into a foreskin opening;

said first handle grip and said first jaw are joined to said second handle grip and said second jaw such that moving said first handle grip and said second handle grip toward each other moves said first jaw and said second jaw away from each other;

a ratchet means pivots between said first handle grip and said second handle grip adjacent said first handle grip second end and said second handle grip second end;

said ratchet means is designed to selectively prevent said first handle grip and said second handle grip from moving away from each other;

a first enlarged hook means on said first blade second end and a second enlarged hook means on said second blade second end, said first enlarged hook means and said second enlarged hook means having tip sides and front sides and rear sides with said enlarged hook means first and second enlarged hook means tip sides formed so as to protrude, and said rear side of said first elongated hook means and said rear side of said second elongated hook means protrude to prevent said first blade and said second blade from slipping out of a foreskin opening when said first blade and said second blade enlarged hook means front sides are separated within a foreskin opening so that said phimosis curer will not damage the foreskin when it is inserted into the foreskin opening and said blades are separated.

Claim 2. A phimosis curer as in claim 1 including:

a fulcrum pin attaching said first handle grip and said second handle grip together so that said first handle grip and said first jaw can be pivoted relative to said second handle grip and said second jaw.

Claim 3. A phimosis curer as in claim 2 wherein:

said ratchet means includes a curved rack with an upper surface, a lower surface, a first side surface and a second side surface, a first end, a second end, cogs, and a pawl;

said curved rack first end is attached to said first handle grip second end by a first pivot pin; said pawl is attached to said second handle grip second end by a second pivot pin.

Claim 4. A phimosis curer as in claim 3 wherein:

 said curved rack is provided with a slot along its interior length;

 said pawl fits within said curved rack slot;

 said slot is wide enough to accommodate said pawl in both the engaged position, against said cogs on said curved rack when said first handle grip and said second handle grip are pivoted toward each other, and the disengaged position, away from said cogs on said curved rack, for permitting said first handle grip and said second handle grip to be pivoted away from each other.

Claim 5. A phimosis curer as in claim 3 wherein:

 said curved rack is provided with one smooth side surface and one irregular cog surface;

 said curved rack irregular cog surface pivots toward said pawl to selectively engage said pawl with said irregular cogs, and away from said pawl to remove said curved rack from contact with said pawl.

Claim 6. A phimosis curer as in claim 3 wherein:

 said curved rack lower surface has a guide groove;

 said second handle grip second end has a spring-loaded projection;

 a stop is positioned on said second handle grip second end on said first side surface of said curved rack second end and said pawl is positioned on said second side surface of said curved rack to limit pivotal movement of said curved rack about said first pivot pin to keep said spring-loaded projection against said curved rack lower surface at all times.

Claim 7. A phimosis curer as in claim 6 wherein:

 said spring-loaded projection extends into said guide groove when said guide groove is positioned above it;

 said guide groove controls the pivotal movement of said curved rack about said first pivot pin when said projection is in said guide groove to maintain said pawl disengaged from said cogs on said curved rack.

Claim 8. A phimosis curer as in claim 7 wherein:

 said guide groove terminates in a decreasing depth taper adjacent to said curved rack second end so that moving said first handle grip and said second handle grip away from each other pushes said projection from said guide groove by pressing said projection into said second handle grip;

 resilient means bias said curved rack toward said pawl to maintain said pawl in engagement with said cogs when said projection is released from said guide groove.

Claim 9. A phimosis curer as in claim 1 wherein:

 said enlarged hook means are in the general shape of a ball with finished smooth curved surfaces and with spaces provided to preclude damage to the penis glands and from pinching the foreskin.

Claim 10. A phimosis curer as in claim 9 wherein:

 said enlarged hook means are coated with an inert material not harmful to the human body.

Claim 11. A phimosis curer as in claim 1 wherein:

 said first handle grip and said first jaw and said first blade and said first enlarged hook
means are one integral part;

 said second handle grip and said second jaw and said second blade and said second
enlarged hook means are one integral part.

Claim 12. A phimosis curer as in claim 3 wherein:

 a bias means with said first pivot pin for biasing said cogs on said ratchet means curved
rack toward said pawl.

Claim 13. A phimosis curer as in claim 1 wherein:

 said first handle grip and said first jaw and said first blade and said first enlarged hook
means and said second handle grip and said second jaw and said second blade and said second
enlarged hook means are all one integral shaped spring element.

Claim 14. A phimosis curer as in claim 13 wherein:

 said first handle grip first end and said second handle grip first end are united together;
 said first jaw and said second jaw cris-cross each other.

Claim 15. A phimosis curer as in claim 13 wherein:

 said ratchet means has a flat rack having a first side edge and a second side edge;
 said flat rack is attached to said second handle grip;

cogs are formed along said flat rack first side edge;
said ratchet means is engaged by selectively placing said first handle grip into one of said
cogs on said flat rack first side.

Claim 16. A phimosis curer as in claim 2 including:

a spring with said fulcrum pin for biasing said first handle grip and said second handle grip
away from each other.

ix EVIDENCE APPENDIX

References relied on by the Examiner:

- Chang, U.S. 6,663,562, issued 12 December 2003
- Ramamurti et al, U.S. 6,635,072, issued 21 October 2003
- Brennan et al, U.S. 6,450,975, issued 17 September 2002
- Seber et al, U.S. 1 6,748,829 issued 15 June 2004

x. RELATED PROCEEDINGS APPENDIX

A petition is being filed concurrently herewith under 37 CFR 1.181.